

Notice of Allowability

Application No.

10/826,059

Examiner

Susan W. Berman

Applicant(s)

TAKABAYASHI ET AL.

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to AMENDMENT AFTER FINAL REJECTION FILED 02-09-2007.
2. ☒ The allowed claim(s) is/are 4-15 and 26-31.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of the:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

Election/Restrictions

Claims 1-11 and 26-31 are directed to an allowable product. Pursuant to the procedures set forth in MPEP § 821.04(B), claims 12-15, directed to the process of making an allowable product, previously withdrawn from consideration as a result of a restriction requirement, are hereby rejoined and fully examined for patentability under 37 CFR 1.104.

Because claims 12-15, the Group II method claims previously withdrawn from consideration under 37 CFR 1.142 have been rejoined, **the restriction requirement with respect to Group II as set forth in the Office action mailed on 06-15-2006 is hereby withdrawn.** In view of the withdrawal of the restriction requirement as to the rejoined invention, applicant(s) are advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once the restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

The restriction requirement with respect to Group III, claim 16, is maintained.

Response to Arguments

The Declaration under CFR 1.132 filed by Toshiyuki Takabayashi has been considered and found unpersuasive with respect to a showing of unexpected results for the following reasons. The comparative data representing the disclosure of JP '474 employs (3-trifluoromethylphenyl)di(4-tolyl)sulfonium hexafluorophosphate as the photogenerating acid, as

Art Unit: 1711

used in Examples 1-3 of JP '474. This sulfonium salt is compared with a sulfonium salt of instantly disclosed formula (13), which is a di(4-methoxyphenyl)(tolylthiophenyl)sulfonium pentafluorophenylborate, which represents formula (2) in the instant claims. JP '474 teaches hexafluorophosphates and hexafluoroantimonates of sulfonium salts corresponding to formula (1) in the instant claims. JP '474 does not teach sulfonium salts corresponding to formula (2) in the instant claims or sulfonium pentafluorophenylborates. The closest teaching of JP '474 to instantly claimed formula (1) sulfonium salt is considered to be sulfonium salt of formula (1) with "X" being an alkyl group, such as methyl, and R_{1-5} being 4 hydrogen and one of 2-methoxyethyl or 2-ethoxyethyl. A closer comparison from the instant disclosure to the sulfonium salts taught by JP '474 would be one selected from the sulfonium salts taught in the instant specification would be with compound S-8 or compound S-10 (pages 28-29). No comparative data comparing the instantly claimed sulfonium salts of formula (1) with the closest prior art disclosure of sulfonium salts of formula (1) taught by JP '474 has been made of record.

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

The application has been amended as follows:

Cancel claim 16.

Art Unit: 1711

Change the status identifier for claim 12 from "withdrawn-currently amended" to "currently amended".

Change the status identifier for each of claims 13-15 from "withdrawn" to "original".

REASONS FOR ALLOWANCE

The following is an examiner's statement of reasons for allowance: See applicant's Remarks filed 02-09-2007, wherein applicant points out the differences between the instantly claimed sulfonium salts and those set forth by JP 2002-241474 A, of record. In the instantly claimed sulfonium salts of formula (1) R_1 , R_2 and R_3 are required to include at least one alkoxyphenyl group or to each be methyl.

The following US Publications are cited as art of interest: US 2005/0288386 A1 and US 2005/0215657 A1.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan W. Berman whose telephone number is 571 272 1067.

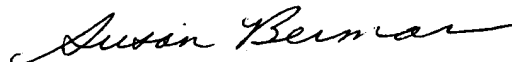
The examiner can normally be reached on M-F 9:30-6:00.

Art Unit: 1711

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571 272 1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SB
3/5/07


Susan W Berman
Primary Examiner
Art Unit 1711